THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte VI T. NGUYEN and PATRICK A. GROSSO

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Appeal No. 96-0205
Application No. 08/000,946[1]

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HEARD: June 8, 1999

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Before JOHN D. SMITH, WALTZ and SPIEGEL, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 14-25. In response to a new rejection in the answer, appellants filed an amendment

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[1] Application for patent filed January 5, 1993. According to the appellants, the application is a continuation-in-part of Application No. 07/557,196, filed July 24, 1990, now abandoned.

presenting new claims 26-38. Accordingly, claims 14-38 are before us for our consideration in this appeal.

Claims 14 and 26 are representative and are reproduced below:

14. A vulcanized tire comprising a carcass, at least a portion of said carcass being made of a composition comprising

(a) a halogen-containing copolymer of a $C_4$ to $C_7$ isomonoolefin and a para-alkylstyrene;

(b) a rubber selected from the group consisting of natural rubber, styrene butadiene polymer, and mixtures thereof;

(c) carbon black; and

(d) a plasticizer oil;

said carcass, when vulcanized having an air permeability of 1.4 or less when measured at room temperature.

26. A vulcanized tire comprising a carcass, at least a portion of said carcass being made of a composition comprising:

(a) as an elastomer,

(1) a halogen-containing copolymer of a $C_4$ to $C_7$ isomonoolefin and a para-alkylstyrene; and

(2) a blend of a natural rubber and a copolymer of styrene and butadiene,

(b) carbon black; and

(c) a plasticizer oil.

The references of record now relied upon by the examiner are:

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| Young | 5,063,268 | November 5, 1991 (filed June 8, 1990) |
| Wirth | 3,658,639 | April 25, 1972 |

References cited by appellants are:

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|---|---|---|
| Powers et al. (Powers) | EPA 0 344 021 | November 29, 1989 |

Encyclopedia of Chemical Technology, Kirk-Othmer, John Wiley & Sons, Inc., Third Edition, Volume 8, pp. 495-500, © 1979.

The appealed claims now[2] stand rejected under 35 U.S.C. § 103 as unpatentable over Young combined with Wirth. We reverse.

The subject matter on appeal is directed to a vulcanized tire comprising a carcass at least a portion of which is made from a composition comprising, inter alia, a halogen containing copolymer (e.g., a brominated isobutylene para-methylstyrene copolymer) as defined in the claims. The carcass of the claimed tire is said to enjoy an enhanced reduction in air permeability and an increase in heat aging resistance as measured by elongation retention. The composition also contains an additional rubber component which

[2] See the supplemental answer entered April 1, 1996.

in a preferred embodiment (appealed claims 26-38) is a blend[3] of natural rubber and a copolymer of styrene and butadiene.

As evidence of obviousness of the claimed subject matter on appeal, the examiner relies on the combined disclosures in Young and Wirth. We reverse the stated rejection based on Young and Wirth because the examiner has failed to establish an adequate factual basis to support a legal conclusion of obviousness of the claimed subject matter. While it is undisputed that Young discloses a vulcanizable rubber composition identical to the composition used by appellants in their invention, Young uses the composition to form a tire tread, not a tire carcass as claimed herein, and as emphasized in the Young declaration[4] of record, this prior art patent does not teach any property of this composition that would be desirable for a tire carcass. See paragraph 4 of page 4 of the declaration. That Wirth discloses that a specific EPDM

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[3] Carcasses for passenger vehicle tires are usually made from blends of natural rubber and SBR (styrene butadiene rubber). See page 210 of Natural Rubber and the Synthetics, Allen et al. (Allen), published by John Wiley & Sons, pp. 208-211, © 1972, a publication of record herein.

[4] This declaration was filed with appellants' reply brief on August 21, 1995.

rubber may be used to make tire carcasses, tire treads, and sidewalls is no indication or suggestion that Young's rubber composition may be used for the same purposes, or that Young's rubber composition may be used to form a tire "consisting solely of the recited composition" as argued by the examiner in his communication entered September 15, 1995 as Paper No. 21. In this regard, the Kirk-Othmer publication relied on by appellants discloses at page 499 that although "it appears that an entirely serviceable all-EPDM tire can be built, there are no such tires currently being made (emphasis added)."

In light of the above, we are constrained to reverse the stated rejection of the appealed claims.

**OTHER ISSUES**

In appellants reply brief at page 7, appellants acknowledge that the "halogen containing copolymer" component used in the herein claimed vulcanized tire carcass is itself the subject of applications for patents, and that the polymeric material is described in EPA 0 344 021 published November 29, 1989. Prior to taking any further action in this application, the examiner should carefully review the

disclosures of this reference, particularly pages 16 and 17, to determine if any of the

properties attributed to this polymer would have provided a suggestion to a person of ordinary skill in the art to have used the polymer as a component of a conventional tire carcass rubber blend.

**REVERSED**

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| JOHN D. SMITH<br>Administrative Patent Judge | ) | |
| THOMAS A. WALTZ<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| CAROL A. SPIEGEL<br>Administrative Patent Judge | ) | |

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Appeal No. 96-0205
Application No. 08/000,946

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